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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,993	08/27/2003	David J. Schneider	P755-2/HSCH 2 00007	4365
27885	7590	09/23/2008		
FAY SHARPE LLP				
1100 SUPERIOR AVENUE, SEVENTH FLOOR				
CLEVELAND, OH 44114				
EXAMINER				
ANDERSON, JAMES D				
ART UNIT		PAPER NUMBER		
1614				
MAIL DATE		DELIVERY MODE		
09/23/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/648,993

Applicant(s)

SCHNEIDER, DAVID J.

Examiner

JAMES D. ANDERSON

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43-48 and 50 is/are allowed.
- 6) ☒ Claim(s) 49 and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-108)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/9/2008 has been entered.

Formal Matters

Applicants' response, filed 9/9/2008, is acknowledged and entered. Claims 43-51 are pending and under examination.

Response to Arguments

Regarding the 35 U.S.C. 101 rejection of 43-51 as claiming the same invention as claims 1-16 and 26-39 of prior U.S. Patent No. 6,749,804 and claims 1-12 and 20-30 of U.S. Patent No. 6,616,892, Applicants argue (remarks, page 4, fifth paragraph) that:

...the test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent, or vice versa. MPEP § 804(11)(A). In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). If the answer is yes, then identical subject matter is not present and double patenting has not occurred. As explained in previous responses, identical subject matter is not present because lowering the pH is distinguishable from ammonia and odor reduction. In particular, ammonia and odors can be reduced without lowering the pH to less than 5. Thus, identical subject matter is not present and § 101 does not apply.

Applicant continues (remarks, page 4, sixth paragraph):

The Examiner appears to be inconsistently considering the claim preambles of the reference claims to be claim limitations while not considering the claim preamble of instant independent claim 43 to be a limitation. Applicant submits that the preamble of claim 43 should be considered a limitation

These arguments are persuasive regarding claims 43-47 and 50, but not persuasive regarding claims 49 and 51 with respect to claims 1-16 and 26-39 of the '804 patent. These arguments are further persuasive regarding claims 43-51 with respect to claims 1-12 and 20-30 of the '892 patent.

However, with respect to claims 49 and 51 and claims 1, 5, 9, 26, 30 and 33 of the '804 patent, instant claims 49 and 51 require the step of soaking an animal habitat with an aqueous solution of trichloromelamine (claim 48), wherein the concentration of trichloromelamine is from about 25 ppm to about 1000 ppm (claim 49) or from about 100 ppm to about 200 ppm (claim 51). Claims 5 and 30 of the '804 patent require the step of soaking an animal habitat with an aqueous solution of trichloromelamine wherein the concentration of trichloromelamine is from about 100 to about 200 ppm. Claims 9 and 33 of the '804 patent require the step of soaking an animal habitat with an aqueous solution of trichloromelamine (claims 5 and 30), wherein the concentration of trichloromelamine is from about 25 ppm to about 1000 ppm (claims 9 and 33, which depend from claims 5 and 30). Accordingly, regardless of the purpose for which trichloromelamine is being applied to the animal habitat, the same concentration of an aqueous solution of trichloromelamine is being applied to the same animal habitats.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

U.S. Patent No. 6,749,804

Claims 49 and 51 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 5, 9, 26, 30 and 33 of prior U.S. Patent No. 6,749,804. This is a double patenting rejection.

The instant claims recite a method of "controlling Darkling beetles" comprising treating an animal habitat with trichloromelamine *such that* the pH of the habitat is lowered to less than 5. The claims of the '804 patent recite methods of reducing the production of ammonia and

odors in an animal habitat and “sanitizing” an animal habitat comprising applying an *effective* amount of trichloromelamine. The method steps of the pending claims and the claims of the ‘804 patent are identical. For example, both sets of claims require the step of soaking an animal habitat with an aqueous solution of trichloromelamine (compare instant claim 48 with claims 5 and 30 of the ‘804 patent), wherein the concentration of trichloromelamine is from about 100 ppm to about 200 ppm (compare instant claim 51 with claims 5 and 30 of the ‘804 patent) or from about 25 ppm to about 1000 ppm (compare instant claim 49 with claims 9 and 33 of the ‘804 patent). As such, the results of such treatment will be the same and are inseparable with respect to patentability.

As there is no evidence of record that applying an aqueous solution trichloromelamine to an animal habitat in the amounts claimed in the ‘804 patent (which are the same as those instantly claimed) will not result in a lowering of pH and control of insects (in fact, such evidence cannot be shown because identical amounts of trichloromelamine are being applied in an identical manner), the instant claims recite the same invention as that claimed in the ‘804 patent. In fact, at column 5, lines 24-31 of the ‘804 patent, it is disclosed that application of TCM **in accordance with this invention** has “*indirect* insecticide properties”. As such, practice of the invention recited in claims 1, 5, 9, 26, 30 and 33 of the ‘804 patent will necessarily result in the pH of the habitat being lowered to a pH less than 5 and thus control Darkling beetles as recited in instant claims 48, 49, and 51. Accordingly, the Terminal Disclaimer filed 3/16/2007 is insufficient to overcome this rejection.

Allowable Subject Matter

Claims 43-48 and 50 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES D. ANDERSON whose telephone number is (571)272-9038. The examiner can normally be reached on MON-FRI 9:00 am - 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James D Anderson/
Examiner, Art Unit 1614

/Ardin Marschel/
Supervisory Patent Examiner, Art Unit 1614